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EXAMINER

TYLER, CHERYL JACKSON

ART UNIT	PAPER NUMBER
3746	

DATE MAILED: 01/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/829,248	MCCARTNEY, PATRICK M.
	Examiner Cheryl J. Tyler	Art Unit 3746

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 06 November 2002.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-34 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-34 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.

4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

## FINAL ACTION

### ***Claim Objections***

1. Claims 10-16, 22-23, 30-31 are objected to because of the following informalities:

- The recitation of "internal pump" (claim 10, line 2; claim 13, lines 1-2; claim 14, lines 1-2; claim 15, line 2; claim 30, lines 1-2; claim 31, lines 1-2) is presumed to be --gear pump-- for proper antecedent basis.
- The recitation of "lubricant pump" (claim 16, line 2; claim 22, line 1) is presumed to be --gear pump-- for proper antecedent basis.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 13, 15-17, and 30 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The independent claims, from which the claims 13, 15-17, and 30 depend, recite a "gear pump" for providing lubrication to a submersible motor. It is unclear how an impeller pump or a vane pump can meet the limitations for an art-recognized "gear pump." Since the

claims are too ambiguous in scope, no prior art could reasonably be applied to the claims. However, this is not to be a presumed indication of allowable subject matter.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 9-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 9 recites a "desired location" in line 5 of the claim. It is not clear as to what constitutes the recited "desired location."

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1, and 7-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Carter (3,975,117). Carter teaches a large casing 11 (corresponding to the claimed housing); a shaft 33 disposed within the casing; anti-friction ball bearing assembly 34, 47 (corresponding to a plurality of wear surfaces) that support the shaft; an inducer

impeller pump 37 (corresponding to the lubricant pump) disposed within the casing at axial end thereof; central bore 64 (corresponding to the claimed conduit); a stator 31 disposed within the casing; and a rotor 32 rotatably mounted within the stator and mounted on the shaft. Carter teaches that "the inducer impeller 37 suspended on the bottom of the motor shaft 33 is rotated so that its vanes 39 will induce an upward flow of the fluid through the annular passage 24 between the motor housing 17 and the surrounding casing 14. The vanes 18 in this passage 24 will diffuse rotation of the fluid created by the rotating vanes 39 to axial flow. The axially flowing fluid passes through the inwardly converging passages 25 provided in the cap 16 to inlet 26 of the first pump stage where the fluid enters the eye of the shrouded impeller 53 ... Some of the fluid from the pumping chambers 27 will flow between the adjacent impellers and the overlying walls 83 of the cup members 82 into the chambers 86 which communicate with the bores 64 in the motor shaft 33 through the passages 6 and 87. This fluid is discharge from the motor shaft bore 64 through the passages 65 in to the bottom of the motor housing 17 and can flood this motor housing to eventually leak through the bottom bearing 34 and the bearing bushing 45 back to the inducer to merge with the incoming fluid impelled by the inducer and thus, be recirculated back through the passage 24. Likewise, the bled-off fluid in the top of the motor housing 17 can flow through the bearing 47 and bushing 62 back to the first stage pump inlet 26 to merge with the fluid from the passages 25. In this manner, the motor compartment is cooled and the bearings are lubricated" (column 5, line 44 - column 6, line 17).

8. Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Gilbert (6,422,346). Gilbert teaches motor means 16, which includes the claimed stator and rotor (as illustrated in patent number 6,132,177, which was incorporated by reference in the '346 patent) disposed within a housing (unnumbered, but clearly illustrated in Figure 1); a crankshaft 12 (corresponding to the claimed rotatable shaft) at least partially disposed within the housing; a plurality of wear surfaces that support the crankshaft 12 (unnumbered, but disclosed in column 3, lines 14-15); an internal lubricant pump (generally indicated as 54) disposed within the housing and circumferentially about the crankshaft; oil passage 18 (corresponding to the claimed conduit); pumping chamber 36 (corresponding to the claimed eccentric oil cavity); vanes 26 (corresponding to the claimed plurality of blades) slidably mounted to the pump rotor. Gilbert teaches that the oil passage 18 "is formed in said shaft generally longitudinally thereof for conveying lubricating oil to various portions of the compressor such as drive shaft mounting bearings, wrist pins and the like" (column 3, lines 13-15).

#### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbert (mentioned previously) in view of Klumpp et al. (5,211,544). Gilbert meets the

limitations of the claim, except that Gilbert employs a vane pump rather than a gear pump in order to pump the lubricant. Klumpp et al. teaches that the two pumps were art recognized equivalents (see column 4, lines 9-10) at the time of the invention in those lubrication applications where it is immaterial whether the circulation means is an impeller, vane, or gear, one of ordinary skill in the art would have found it obvious to substitute a gear pump for the Gilbert vane pump.

11. Claims 9-12, 18-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parmeter et al. (5,828,149) in view of Klumpp et al. (mentioned previously).  
Parmeter et al. teach a casing 11 (corresponding to the claimed outer housing); a shaft 31 disposed within the casing; radial support bearings 35 (corresponding to the claimed plurality of wear surfaces that support the shaft; an inducer pump 57 with helical flights 61 (corresponding to the claimed lubricant pump having an impeller) disposed within the casing at an axial end thereof; a shaft bore 53 and lateral passages 55 (corresponding to the claimed conduit); a centrifugal pump 17 (corresponding to the claimed submersible pump); a seal section 15 (corresponding to the claimed motor protector); motor 13 (corresponding to the claimed submersible motor). Parmeter et al. teach that "the motor 13 and the seal section 15 will be filled with a lubricating oil" (column 3, lines 52-53). Parmeter et al. further teach that "As shaft 31 rotates, inducer 57 will rotate with it. This causes lubricant in chamber 51 to pass through filter 64, up outlet 65, and into shaft bore 53. Inducer 57 pumps the lubricant up shaft bore 53 and out lateral passages 55. The upper end of shaft bore 53 may be open in which case some of the lubricant will discharge into seal section 15 ..." (column 3, lines 59- 65). As illustrated in

Figure 1, the submersible motor is combined with the seal section 15 and the centrifugal pump 17.

Parmeter et al. meet the limitations of the claims, except that Parmeter et al. employ an impeller pump rather than a gear pump in order to pump the lubricant. Klumpp et al. teaches that the two pumps were art recognized equivalents (see column 4, lines 9-10) at the time of the invention in those lubrication applications where it is immaterial whether the circulation means is an impeller, vane, or gear, one of ordinary skill in the art would have found it obvious to substitute a gear pump for the Parmeter et al. impeller pump.

### ***Double Patenting***

12. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

13. Applicant is advised that should claim 9 be found allowable, claim 14 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing

one claim to object to the other as being a substantial duplicate of the allowed claim.

See MPEP § 706.03(k).

### ***Response to Arguments***

14. Applicant's arguments filed 11/6/2002 have been fully considered but they are not persuasive. The applicants argue that the 35 U.S.C. § 112, second paragraph rejection is not applicable since the applicant may be his own lexicographer. While this may be true, the claims are read in light of the specification, and limitations from the specification are not read into the claims. This being said, the term "desired location" is not definite since it is not clear, in the claims, as to what constitutes this location. If the applicants wish for the "desired location" to be the orientation described in page 7, line 20 - page 8, line 8, then, they should so designate in the claims.

With regards to the argument that the Carter reference does not contain an internal pump disposed within the housing and circumferentially around the shaft, the Examiner respectfully disagrees. Carter teaches the pump internal to the casing 11 and disposed circumferentially around the shaft, as well as a stator and rotor disposed within the same casing. The applicant argues that the pump is not within a "motor housing," which has not been claimed. The claim merely requires that there be a stator and rotor *within a housing* and an internal lubricant pump within the same housing, as Carter teaches. Thus, the rejections are proper and remain.

With regards to the argument that the Parmeter et al. reference teaches an impeller pump rather than the gear pump, in the amended claims, the rejection now

includes reference to the Klumpp et al. reference which teaches the functional equivalence of using an impeller, vane, or gear pump. As the applicant himself teaches the functional equivalence of the three pumps, absent a showing of new and unobvious results, one of ordinary skill in the art at the time the invention was made would have known how to substitute a gear pump for an impeller pump. Thus, these arguments are not persuasive in view of the new grounds of rejection, necessitated by the applicant's amendment.

***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Loprete et al. (6,132,177) was incorporated by reference in the Gilbert ('346) reference.

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Contact Information***

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl J. Tyler whose telephone number is 703-306-2772. The examiner can normally be reached on Monday-Thursday, 6:00 - 10:30 am.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy S. Thorpe can be reached on 703-308-0102. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.

*Cheryl J. Tyler*  
Cheryl J. Tyler  
Primary Examiner  
Art Unit 3746

CJT  
January 6, 2003